

Response to Office Action  
SN 10/612,504  
Customer No. 33354

## REMARKS

### A. Status of the Claims

Claims 1-10, 13-30, and 32 are pending and stand rejected. Claims 35-39 were withdrawn by the Examiner. Claims 1 and 23 are amended herein. Claims 30 and 32 are cancelled herein.

### B. Restriction Improper

The Examiner has withdrawn claims 35-39 for being drawn to a distinct invention because the methods have been classified in different classifications. While the Examiner may restrict if each distinct subject has attained a separate classification, if related inventions are not patentably distinct as claimed, restriction under 35 USC 121 is never proper. MPEP §808.02 and §806.05.

It is common in the laser arts to include method claims with the device claims, as indicated by most of the patents cited by the Examiner against the present application, including Lai and Gerdes. In the present case, it is possible that the device and method as claimed are so related that they would be deemed not patentably distinct, and therefore, if restricted, Applicants may suffer another double patenting rejection.

Therefore, Applicants respectfully request that this restriction be withdrawn and the claims examined.

If the restriction is maintained, Applicants accept the invention elected by the Examiner.

### C. Amendments to the Specification

The Examiner again notes in this office action that the full continuation data including the patent number is required. Applicant believes that that amendment was properly made in its reply dated October 3, 2005, but, in doing so, Applicant inadvertently eliminated the "Field of Invention." Therefore, Applicant respectfully requests that the Examiner enter the amendment presented in this paper.

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#### **D. Double Patenting**

The Examiner continues to reject claims 1-10, 13-14, 17, 18, 21 and 23-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 13 of U.S. Patent 6,746,473. Upon a notice of allowance, and assuming such terminal disclaimer is still required, Applicants will file a terminal disclaimer and an assignment fully complying with 37 CFR § 1.321 and 37 CFR § 3.73.

#### **E. § 102 Rejections Citing Tatebayahsi and Gerdes**

The Applicants thank the Examiner for considering Applicant's earlier arguments regarding § 102 rejections over Tatebayahsi and Gerdes and finding them persuasive.

#### **F. Final Rejection Premature**

However, the Examiner has raised new §102 rejections over US 6,074,411 issued to Lai et al ("Lai") and simultaneously made the office action final. Applicants believe the Examiner made the final rejection prematurely and respectfully request that it be withdrawn.

##### **1. No Clear Issue Developed**

For a final rejection to be proper on the second or subsequent examination, a clear issue should be developed between the Examiner and applicants. MPEP §706.07. Switching from one set of references to another by the Examiner in rejecting in successive actions claims of substantially the same subject matter will tend to defeat attaining the goal of reaching a clearly defined issue. *Id.*

In this case, Applicants' amendments resulted in substantially the same subject matter, and the scope of the claims was not expanded. So, the Examiner was examining substantially the same subject matter each time, but switched

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from the Tatebayashi set of references to the Lai set of references. Switching from one set of references to another in rejecting in successive actions claims of substantially the same subject matter is contrary to the recommended practice in the MPEP and prevents the opportunity to have a full and fair hearing of the issues or a clear issue from being developed. For this reason, Applicants believe the final rejection was premature and respectfully request that the Examiner withdraw it.

## **2. New Reference Was Not Applied in Timely Fashion**

Further, the rejection over Lai is new. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly with both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied. *Id.*

Although cited on form PTO-892 in the first office action, Lai was not applied in any of the earlier office actions, which now number four. The Examiner's reasoning to explain the application of Lai in the present office action would have been applicable to the claims as written in all prior versions of the claims. That is, the Examiner could have and was obligated to make rejections over Lai if applicable at the earliest time, which Applicants believe was after the first office action, but certainly before the fourth, and final, office action. Clearly the Examiner conducted a proper search to cover the claimed subject matter and features that might reasonably expected to be claimed, however it appears that he did not fully apply the references he found in the first or two subsequent actions, specifically Lai. MPEP §904.

Where multiple references each anticipate, it is common for the Examiner to apply and explain each reference in the first office action in which it is raised so that the references are fully applied and the prosecution be confined to as few actions as consistent with a thorough consideration of its merits. See *Id.* Again, the introduction of Lai at final, without the opportunity to have a full and fair hearing of the issues, prevents a clear issue from being developed. Without a

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clear issue being developed, Applicant cannot be assured subsequent compliant amendments will be entered, nor assured that the application is in form for appeal. For this reason, Applicants believe the final rejection was premature and respectfully request that the Examiner withdraw it.

### **3. New Rejection Not Necessitated by Applicants' Amendment or IDS**

Finally, a final rejection on the second or subsequent examination shall be proper except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. MPEP §706.07(a).

In this case, Applicants' amendments made to the rejected claims on the prior (and first) reply of the RCE were amendments resulting in substantially the same subject matter, and the scope of the claims was not expanded. It is illogical that the new ground of rejection was necessitated by Applicants' amendments.

Similarly, the new rejections could not have been based on information submitted in an IDS, because the Lai patent was not submitted by Applicants in an IDS.

Therefore, in this case a final rejection is improper because the Examiner introduces a new ground of rejection that was neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Applicants believe the final rejection was premature and request that the Examiner withdraw it.

### **G. §102 Claim Rejections Over Lai**

Assuming that the final action was premature, Applicants present claim amendments and arguments in response to the rejections.

#### **1. Lai Does Not Anticipate Because Lai Does Not Disclose Probes Moved During Treatment**

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The Examiner has rejected independent claims 1 and 30 as being anticipated by Lai. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc., 2 USPQ 2d at 1053.*

The purpose of Lai is to eliminate the need for hand-holding the laser module during treatment, thereby allowing the therapist to perform other tasks during treatment. See Lai column 2, lines 25-30. This means that Lai does not disclose, either inherently or expressly, that the probes are moved by hand during treatment. Claim 1 has been amended to clarify that the handheld probes are moved by a user's hand during treatment. No new matter has been added with this amendment: paragraph 0024 discloses and FIG. 7 illustrates the probes being held by a practitioner and emitting low-level laser radiation during treatment.

Therefore, claim 1 is not anticipated by Lai and Applicants respectfully request that the Examiner withdraw this rejection.

## **2. Lai Does Not Anticipate Because Lai Does Not Disclose Beam Shaping Apparatus**

The Examiner has rejected independent claim 23 as being anticipated by Lai. Again, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc., 2 USPQ 2d at 1053.*

Lai does not expressly disclose an optical arrangement to transform the beams into desired spot shape, as admitted by the Examiner on page 4 of the present office action. Instead, Lai discloses only focusing optics. See Lai column 2, line 30. However, focus is not the same thing as shape. Focus refers to how clear or fuzzy the image is, whereas shape refers to the perimeter geometry of the image as it impinges the patient's skin. See Applicant's specification at paragraph 0017. Focus is defined in optics as "the clear and sharply defined condition of an image" and "the position of a viewed object or the adjustment of

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an optical device necessary to product a clear image." Random House Unabridged Dictionary 2<sup>nd</sup> ed., 1987, meanings 3c and 3d, respectively. A device can emit a beam shape that is in or out of focus, and focusing the beam will not change the underlying shape. That is, focusing optics are not inherent in beam shaping optical arrangements. For example, a linear beam has a linear shape, but may be in or out of focus:



linear beam spot  
in focus



linear beam spot  
out of focus

Similarly a circular beam spot may be in or our of focus:

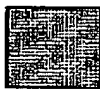


circular beam spot  
in focus



circular beam spot  
out of focus

Similarly a square beam spot may be in or our of focus:



square beam spot  
in focus



square beam spot  
out of focus

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Lai does not disclose, either expressly or inherently, an optical arrangement for transforming the beam shape. Therefore, claim 1 is not anticipated by Lai and Applicants respectfully request that the examiner withdraw this rejection.

### **3. Conclusion – No Anticipation**

Claim 1 as amended and its dependent claims are not anticipated by Lai because Lai does not disclose moving the probes during treatment nor an optical arrangement for shaping the beam spot. Therefore, Applicants respectfully request that this rejection be withdrawn. The Examiner is also requested to withdraw his rejection of dependent claims 2, 8-10, 13-15, and 22 based on their dependency on an allowable base claim. Claim 30 has been cancelled.

### **H. §103 Claim Rejections Over Lai and Gerdes**

The Examiner has rejected claims 3-7, 16-22, and 23-29 as being obvious in light of Lai in view of US 6,267,779 to Gerdes ("Gerdes"). A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP* §2143.

The rejected claims teach, in general, two or more handheld probes that are freely moved by the user's hand while the laser beams are emitted during treatment. However, the whole point of Lai is to eliminate the need for hand-holding the laser module during treatment, thereby allowing the therapist to perform other tasks during treatment. See Lai column 1, lines 30-32, lines 47-48; column 2, lines 25-30; and all claims. Therefore, Lai expressly teaches against probes that are hand-held during treatment. It is improper to combine references when one teaches away from the combination. *MPEP* §2146 and *In re Grasselli*, 218 *UPQ* 769, 779 (*Fed. Cir.* 1983). Therefore, Applicants believe that Lai and Gerdes cannot be combined and that the Examiner has not made a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the obviousness rejections be withdrawn.

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**I. In Alternative, Consider Arguments After Final**

The Examiner may consider claim amendments and arguments after final rejection, if such amendment will place the application in condition for allowance or better form for appeal. MPEP 714.12. In the event the final action is not withdrawn, Applicants respectfully request that the Examiner consider and enter the amendments and arguments presented herein to place the application in condition for allowance or better form for appeal.

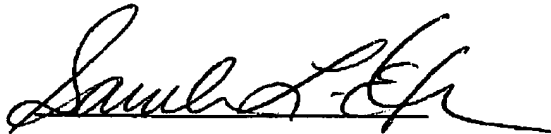
**CONCLUSION**

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance.

Respectfully submitted,

3/8/06

Dated



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